

## **REMARKS**

This is a full and timely response to the non-final Office Action of July 8, 2005.

Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Fourth Response, claims 1-5, 8, 10-14, 17, 19-21, and 23 remain pending in this application. Claims 1, 10, 20, 21, and 23 are directly amended herein, and claims 9, 18, 22 and 24 are cancelled without prejudice or disclaimer. Furthermore, amendments to the specification have been submitted herewith. It is believed that the foregoing amendments add no new matter to the present application.

### **Response to Specification Objections**

The specification presently stands objected to in the Office Action as allegedly failing to provide proper antecedent basis for the claimed subject matter of claims 20, 23, and 24. In particular, with respect to claim 20, it is alleged in the Office Action that the specification fails to mention the “computer-readable medium.” The specification has been amended herein to include the term “computer-readable medium.” Moreover, it is believed that the addition of “computer-readable medium” is not new matter. In this regard, the specification teaches that the tools 10 and 20 can be “software computer programs running on a computer.” See page 3, line 20. One of ordinary skill in the art would realize that a software computer program “running on a computer” is stored on a computer-readable medium. Further, claim 20, as originally filed, forms part of Applicants’ original disclosure and recites a “computer-readable medium.”

Further, with respect to claims 23 and 24, claim 23 has been amended herein, and claim 24 has been cancelled making the objections regarding these claims moot.

Moreover, Applicants respectfully submit that the objections to the specification should be withdrawn.

### **Response to §101 Rejections**

Claims 1-5, 8, 10-14, 19, 21, and 22 presently stand rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. However, Applicants respectfully assert that the pending claims of the instant application are directed to statutory subject matter, and the rejection under 35 U.S.C. §101 is, therefore, improper.

In this regard, it is alleged in the Office Action that the recited elements of claim 1 “clearly indicate that (the invention) is a ***computer program***.” It is then alleged that the invention is neither concrete nor tangible since it fails to recite being “embodied on a tangible computer-readable medium.”

Applicant respectfully traverses the allegation that the recited elements of the invention defined by claim 1 “clearly indicate that (the invention) is embodied on a ***computer program***.” In this regard, it is well known that “logic” may be implemented in software ***or*** hardware. There is nothing in claim 1 that requires the recited “logic” to be implemented only as a computer program.

In addition, it is asserted in the Office Action that “(d)ata structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer.” Applicants respectfully assert that the “logic” recited by claim 1 is not merely a “data structure” that is incapable of causing functional change in a computer. Indeed, the phrase “logic configured to” indicates that the recited “logic” is capable of causing a functional change. Further, pursuant to the Administrative Procedures Act, the Patent Office has a duty to treat all applicants consistently. Many issued patents, including U.S. Patent Nos. 6,148,402; 6,279,154; 6,178,436; 6,292,818; and 6,189,147, for example, have claims reciting “logic

configured to” without reciting that such “logic” is embodied on a “computer-readable medium.” To require Applicant’s claim 1 to recite a “computer-readable medium” would constitute inconsistent treatment of Applicant’s application relative to many previously issued patents.

### **Response to §102 Rejections**

“Anticipation under 35 U.S.C. §102 requires the presence in a single prior art disclosure of *each and every* element of the claimed invention.” *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747; 3 U.S.P.Q.3d 1766 (Fed. Cir. 1987).

#### **Claim 1**

Claim 1 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by <http://web.archive.org/web/19991111161335/http://www.Scriptorium.com/index.html> (hereinafter “*Scriptorium*”). Claim 1, as amended, reads as follows:

1. An apparatus for generating files, the apparatus comprising:
  - a first logic configured to perform a technical writing tool algorithm, the technical writing tool algorithm for receiving input describing a particular selected format and content for a document, ***the technical writing tool algorithm for processing said input to generate a first markup language file of a first markup language based on an elements file and a plurality of style templates external to said elements file***, said elements file defining elements included in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information, ***said first logic configured to define styles of said elements in said first markup language file based on said plurality of style templates, each of said style templates defining a style for a respective one of said elements***; and
  - a second logic configured to receive the first markup language file and to perform a conversion algorithm that converts the first markup language file into a second markup language file of a second markup language based on a plurality of mappings for mapping styles defined by said style templates to styles to be used in said second markup language file, ***said second logic further configured to define styles of elements in said second markup language file based on said styles mapped to said style templates by said mappings***, wherein said second markup language file includes a second markup language formatting information describing a particular on-line format and content of said document. (Emphasis added).

Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 1 highlighted hereinabove. Therefore, the 35 U.S.C. §102 rejection of claim 1 is improper.

In this regard, it is asserted in the Office Action that *Scriptorium* discloses:

“technical writing tool algorithm for processing said input to generate a first markup language file based on an elements file (*Scriptorium* discloses this limitation in that FrameMaker creates an output document in SGML format, which is based on the document structure developed by the user. The ‘structure’ developed by the user is defined in an Element Definition Document.)”

Thus, it is apparently alleged that the Element Definition Document (EDD) of FrameMaker constitutes the “elements file” recited by claim 1. It is further asserted in the Office Action that *Scriptorium* discloses:

“WebWorks Publisher includes a plurality of style templates that may be customized by the user. These style templates are ‘external’ to the Element Definition Document in that the style templates are in the WebWorks Publisher software and the Element Definition Document is in the FrameMaker software.), said at least one style template mapped to at least one of said elements and defining a style for said at least one element (see Page 12 of 14 –*Scriptorium* discloses this limitation in that WebWorks Publisher allows FrameMaker + SCML users to map elements instead of mapping tags. That is, users may map FrameMaker elements to WebWorks Publisher styles.)”

*Scriptorium* indeed discloses that WebWorks Publisher is a “mapping tool” that allows a user to map “FrameMaker tags” to “HTML or WinHelp equivalents.” See page 4. Further, it is apparently alleged in the Office Action that these “HTML or WinHelp equivalents” in WebWorks Publisher constitute the “style templates” recited by claim 1. In particular, it is alleged in the Office Action that “WebWorks Publisher includes a plurality of style templates that may be customized by the user.” However, these alleged “style templates” in WebWorks Publisher do not appear to be used to define the styles for the alleged “first markup language file” (*i.e.*, an SGML file generated by FrameMaker) but rather appear to be used to define the styles for the alleged “second markup language file” (*i.e.*, an HTML file). In fact, it does not appear that the alleged “style templates” in WebWorks Publisher are

used in any way to generate the alleged “first markup language file.” Thus, the alleged “style templates” cannot constitute the “style templates” recited by claim 1. Accordingly, *Scriptorium* fails to disclose at least a “technical writing tool algorithm for processing said input to ***generate a first markup language file based on*** an elements file and ***a plurality of style templates*** external to said elements file... each of said style templates defining a first markup language style for a respective one of said elements,” as recited by claim 1. (Emphasis added).

For at least the above reasons, Applicants respectfully submit that *Scriptorium* fails to disclose each feature recited by pending claim 1. Therefore, the 35 U.S.C. §102 rejection of claim 1 should be withdrawn.

### **Claims 2-5 and 8**

Claims 2-5 and 8 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Scriptorium*. Applicants submit that the pending dependent claims 2-5 and 8 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-5 and 8 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 10**

Claim 10 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Scriptorium*. Claim 10, as amended, reads as follows:

10. A method for generating files, the method comprising:  
processing input describing a particular desired format and content for a document;  
***generating a first markup language file of a first markup language based on said input, an elements file, and a plurality of style templates external to said elements file***, said elements file defining elements included in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file

including first markup language formatting information, ***said style templates defining styles for said elements included in said first markup language file***; and converting the first markup language file into a second markup language file of a second markup language based on a plurality of mappings for mapping styles defined by said style templates with styles to be used in said second markup language file, wherein said second markup language file includes second markup language formatting information that describes a particular on-line format and content of said document when it is placed on-line, and ***wherein said converting comprises defining styles of elements in said second markup language file based on said styles mapped to said style templates by said mappings***. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1, Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 10 highlighted above. Accordingly, the U.S.C. §102 rejection of claim 10, as amended, is improper and should be withdrawn.

#### **Claims 11-14 and 19**

Claims 11-14 and 19 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly being anticipated by *Scriptorium*. Applicants submit that the pending dependent claims 11-14 and 19 contain all features of their respective independent claim 10. Since claim 10 should be allowed, as argued hereinabove, pending dependent claims 11-14 and 19 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

#### **Claim 20**

Claim 20 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Scriptorium*. Claim 20, as amended, reads as follows:

20. A computer program for generating files, the computer program embodied on a computer-readable medium, the computer program comprising:  
a first algorithm, ***the first algorithm processing input describing a particular desired format and a content for a document to generate a first markup language file of a first markup language based on an elements file and a plurality of style templates external to said elements file***, said elements file defining elements included

in said first markup language file and a structure for each of said elements, wherein said first markup language file is printable as a hardcopy document, said first markup language file including first markup language formatting information, ***each of said style templates defining a style for a respective one of said elements***; and

a second algorithm, the second algorithm converting the first markup language file into a second markup language file of a second markup language based on a plurality of mappings, ***each of said mappings for mapping a respective style defined by said style templates with a respective style for said second markup language file, the second algorithm defining styles of elements in said second markup language file based on styles for said second markup language file that are mapped to said style templates by said mappings***, wherein said second markup language file includes second markup language formatting information that describes a particular on-line format and content of said document when it is placed on-line. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1,

Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 20

highlighted above. Accordingly, the U.S.C. §102 rejection of claim 20, as amended, is improper and should be withdrawn.

### **Claim 21**

Claim 21 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by

*Scriptorium*. Claim 21, as amended, reads as follows:

21. An apparatus for generating files, comprising:

***a first logic configured to generate a first markup language file of a first markup language based on an elements file and a plurality of style templates separate from said elements file***, said elements file defining elements included in said first markup language file and a structure for each of said elements, each of said style templates mapped to a corresponding one of said elements and defining a style for said corresponding element, wherein said first markup language file has formatting information based on at least one of said style templates mapped to at least one of said elements included in said markup language file; and

a second logic configured to convert the first markup language file into a second markup language file of a second markup language based on a plurality of mappings, ***each of said mappings for mapping a respective style template to a respective style to be used in said second markup language file***. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1, Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 21 highlighted above. Accordingly, the U.S.C. §102 rejection of claim 21, as amended, is improper and should be withdrawn.

### **Claim 23**

Claim 23 presently stands rejected under 35 U.S.C. §102 as allegedly being anticipated by *Scriptorium*. Claim 23, as amended, reads as follows:

23. A method for generating files, comprising:
- storing an elements file defining markup language file elements and a structure for each of said elements;
  - maintaining a plurality of style templates separate from said elements, each of said style templates mapped to at least a respective one of said elements and defining a style for said one element;***
  - generating a first markup language file of a first markup language based on said elements file and at least one of said style templates that is mapped to at least one of said elements included in said markup language file,*** said markup language file having formatting information based on said at least one style template;
  - converting said first markup language file into a second markup language file of a second markup language based on said elements file and a plurality of mappings for mapping styles defined by said style templates to styles to be used in said second markup language file, wherein one of said mappings maps said at least one style template to a style to be used in said second markup language file for said at least one element;*** and
  - displaying an image of a document defined by said second markup language file. (Emphasis added).

For at least reasons similar to those set forth above in the arguments for allowance of claim 1, Applicants respectfully assert that *Scriptorium* fails to disclose at least the features of claim 23 highlighted above. Accordingly, the U.S.C. §102 rejection of claim 23, as amended, is improper and should be withdrawn.

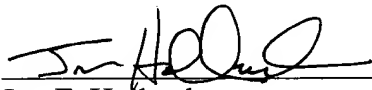


**CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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